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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,325

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Michel Basler

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31743

7590

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Georgia-Pacific LLC

133 Peachtree Street NE - GA030-41

ATLANTA, GA 30303

EXAMINER

DUCHENEAUX, FRANK D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

01/06/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,325	Applicant(s) BASLER ET AL.	
	Examiner FRANK D. DUCHENEAUX	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/2009 has been entered.

Examiner's Note

The substitute specification filed 10/28/2009 has not been entered because a statement as to a lack of new matter under 37 CFR 1.125(b) is missing.

Response to Amendment

2. Applicant's arguments, see pages 5 and 7, filed 10/28/2009, with respect to the objection of the abstract have been fully considered and are persuasive. The objection of the abstract has been withdrawn.

3. Applicant's arguments, see pages 4 and 7, filed 10/28/2009, with respect to the objection of the specification have been fully considered but they are not persuasive. The amendments filed 10/28/2009 are part of the substitute specification which does not contain a statement as to a

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lack of new matter and thus was not entered and as such, the objections are maintained and repeated below.

4. Applicant's arguments, see pages 6 and 8, filed 10/28/2009, with respect to the objection of the drawings in paragraph 11 of the previous action have been fully considered and are persuasive. The objection of the drawings has been withdrawn.

5. Applicant's arguments see pages 6 and 8, filed 10/28/2009, with respect to the objection of the drawings have been fully considered but they are not persuasive. The amendments to the specification filed 10/28/2009 are part of the substitute specification which does not contain a statement as to a lack of new matter and thus was not entered and as such, the objections to the drawings that were fixed via amendments to the specification are maintained and repeated below.

6. Applicant's arguments, see page 8, filed 10/28/2009, with respect to the objection of the claims have been fully considered and are persuasive. The objection of the claims has been withdrawn.

7. Applicant's arguments, see pages 8-13, filed 10/28/2009, with respect to the rejection of claims 1-12 under 35 U.S.C. 112, 2nd paragraph have been fully considered and are persuasive. The rejection of claims 1-12 has been withdrawn.

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Specification

8. The substitute specification filed 10/28/2009 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: the statement as to a lack of new matter under 37 CFR 1.125(b) is missing. As such, the objections to the specification and objections to the drawings fixed by applicants' amendments to the specification are maintained and repeated below.

9. The disclosure is objected to because of the following informalities: 1) The specification lacks appropriate headings for its sections (see above); 2) a word seems to be missing after the word "rigid" on line 11 of page 1; 3) In the description of the drawings for figure 2, the applicants have specified a cross-section as II-II, where the drawings have labeled a cross-section as 2-2; 4) On page 12, line 6 the specification states that "...the embossing of the second ply P2 is as visible on FIGURE 5." The examiner notes that there is no embossment of P2 and further, it is not clear what is meant by this statement. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Drawings

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "20" has been used within the specification in three different manners; as a third cavity, third protuberance and third projection. Corrected drawing sheets in compliance

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with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' attention is directed to, *inter alia*, paragraph 0038, wherein it is disclosed that zones A1 and A2 are adjacent; however, there is no disclosure supporting the broader statement of "associated second zones" as recited in current claim 1. As such, the "associated" limitation constitutes new matter.

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13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. **Claims 1-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the use of the word “associated” is indefinite as it unclear from the claim limitations what constitutes an association between the two zones. The examiner notes that the use of the word “adjacent” in place of “associated” finds support in the disclosure as originally filed.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. **Claims 1-9** are rejected under 35 U.S.C. 102(b) as being anticipated by Graff et al. (WO03/050353). The examiner notes that the referenced portions of the prior art will be taken from US 2005/0034828 A1, which is an English language equivalent to the ~353 publication.

Regarding claim 1, Graff teaches a multi-layer sheet of absorbent paper (title) comprising a first ply (12) and a second ply (14) each made of tissue paper having a surface weight between 12 and 35 g/m², said first ply including a first embossing pattern which is imprinted in first zones (16) having first protrusions (18) projecting from the inner surface of the first ply and corresponding to alveoles (cavities) on the outer surface with said protrusions' tops (19) (first protuberances) being linked (superimposed, adjacent) to the opposite inner surface of the second ply, and further that the first ply includes second embossing pattern constituted of second protrusions (38) (second protuberances) having a height that is shallower than the first protrusions and linked to the inner surface of the second ply (abstract). Graff also teaches that the second protrusions constitute second zones (36), said second protrusions having a height (H2) shallower than the first protrusions (H1) (para 0036, lines 5-8 and figure 2).

It is noted that figure 2 of the reference teaches that the first zones are in relief to the second zones with a level difference of H1 - H2 and that the first and second zones are delimited from each other by a difference in elevation, which constitutes a continuous contour between said zones as currently claimed, while figure 1 of the reference teaches that the first zones (16) are surrounded (first zones forming cells) by the second zones (36) as presently claimed.

Regarding claim 2, Graff teaches that the tops of the first and second protrusions are situated in same plane as the second ply (para 0036, last two lines), which provides the two sets of protrusions with a depth as presently claimed.

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Regarding claim 3, figure 1 of Graff teaches non-embossed zones (white areas on the figure) between the second zones (36).

Regarding claims 4-5 and 8, Graff teaches third protrusions in the form of small partitions connect two adjacent first protrusions (para 0019), which provides third embossed zones between second zones as the first zones (16) are surrounded by second zones (36), while figure 5, reference number 30 demonstrates that the third protrusions form continuous lines connecting the first protrusions generated by embossing tips 28, said third protrusions having a linear shape (see also para 0045).

Regarding claim 6, figure 2 of Graff teaches second protuberances are at least part aligned with the relief demarcation of the first and second zones (at least the leftmost column of second protuberances in the figure)

Regarding claim 7, figure 2 clearly teaches first protuberances having a tapered cross-sectional shape.

Regarding claim 9, figure 2 teaches that 2nd ply (14) is without embossments.

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Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. **Claims 10-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Graff et al. (WO03/050353) in view of Roussel et al (US Patent 6524683 B1). The examiner notes that the referenced portions of the prior art will be taken from US 2005/0034828 A1, which is an English language equivalent to the ~353 publication.

Regarding claims 10-12, Graff teaches a multi-layer sheet of absorbent paper as in the rejection of claims 1-8 above. Graff is silent to a second ply that is embossed and presents protuberances, whereby the two plies are in contact though the tops of the protuberances corresponding to the second and/or third protuberances, that the plies are bonded though glue on the top of the second and/or third protuberances, or that the first protuberances are not glued.

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However, Roussel teaches a sheet of embossed absorbent paper (title) - towards improved pattern resolution and emphasis of a background pattern (column 2, lines 32-34) - of two plies whereby each ply comprises a first embossed zone (column 4, lines 62-63) and two or more adjacent second zones (column 5, lines 49-54) comprising protuberances/salients, whereby the two plies are in contact with each other through the tips of their respective protuberances (figures 1-4 and claim 3). Roussel continues to teach that the salients (protuberances) coincide perfectly (column 4, lines 54-55 and figure 2)) and that the two plies can be assembled by bonding via gluing or knurling (not glued) (column 3, lines 40-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Graff and Roussel references to obtain a tissue paper with specific mechanical properties such as bonding strength, absorptivity, and softness as in the present invention as it is well known in the art that adhesively bonding two plies provides increased bonding strength between said plies while glue also diminishes the softness, and further that bonding two plies together via the tips of their protuberances increases a void volume between said plies, which increases the absorbency of a tissue.

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Response to Arguments

20. Applicant's arguments, see pages 9-12, filed 10/28/2009 with respect to the rejection of claim 1 over Edwards et al under 35 U.S.C. 102(b) have been considered but are moot in view of the new ground(s) of rejection.

The applicants argue that the Edwards reference fails to teach first zones and associated second zones being delimited by a continuous contour formed by a marking line therebetween. In addition, applicants argue that Graff fails to cure the deficiencies of the Edwards reference in regards to currently amended claim 1.

The applicants' attention is directed to the rejection of claim 1 above and to the relevant citations of the Graff reference, wherein Graff clearly discloses and anticipates each and every limitation of amended current claim 1, including a continuous contour formed by a relief between first and second zones.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK D. DUCHENEAUX whose telephone number is (571)270-7053. The examiner can normally be reached on M-Th, 7:30 A.M. - 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. D. D./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794